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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/551,537	04/18/2000	Kazuki Suzawa	P107424-00003	1899

7590 10/18/2002
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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/18/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/551,537	ARIOKA ET AL.	
	Examiner	Art Unit	
	Lawrence D Ferguson	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

Response to Appeal Brief

1. This action is in response to the Appeal Brief mailed July 23, 2002.

Claims 1-5 are pending. Examiner regrets the untimely reopening of this case but feels it is necessary to put the action in a better form of rejection.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurditch et al. (U.S. 5,952,073).
4. Hurditch discloses a recordable medium comprising a protective layer, a reflective layer in proximity to the protective layer, a recording layer with a dye composition in proximity to the reflective layer and a transparent substrate on which the recording layer is formed (column 7, lines 10-16) where the recordable medium comprises a dye layer (column 7, line 64). Hurditch discloses the recording layer is formed by dissolving the dye mixture in a coating solvent at 2-10% by weight of the total components in the solution (column 10, lines 26-29) and typical organic solvents for use with the dye mixtures comprising diacetone alcohol (column 10, lines 44-45) and spin

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coating (column 10, lines 48-49). The reference discloses the dye layer may be optionally dried (column 11, line 8) meaning the dye layer does not necessarily have to undergo a drying treatment. Hurditch does not explicitly disclose the organic dye layer in an amount of 2 to 15% by weight, however the reference does disclose an amount of 2 to 10% by weight (column 10, lines 26-29). Even though Hurditch does not disclose the solvent in an amount up to 15%, the solvent range is optimizable because it affects the reflecting layer of the recording medium. It would have been obvious to one of ordinary skill in the art to optimize the components because discovering an optimum or workable range involves only routine skill in the art. *In re Aller*, 105 USPQ 233 and also see *In re Boesch* 205 USPQ 215.

Claim Rejections – 35 USC § 103(a)

5. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurditch et al. (U.S. 5,952,073) in view of Cunningham et al (U.S. 5,547,728).

6. Hurditch is relied upon for claims 1 and 3-4. Hurditch does not disclose the rotating speed for the spin coating. It would have been obvious to one of ordinary skill in the art to find the optimum rotating speed in order to provide optimal working conditions. Hurditch also does not disclose the organic solvent as 2,2,3,3-tetrafluoro-1-propanol.

Cunningham teaches an optical recording element having a transparent substrate, a recording layer and a light reflecting layer (abstract) and a protective layer over the reflective layer (column 10, line 65). Cunningham teaches the use of coating solvents such as 2,2,3,3-tetrafluoro-propanol. Hurditch and Cunningham are analogous

art because they are from the same field of recording medium. It would have been obvious to combine the organic solvent, 2,2,3,3-tetrafluoro-propanol, as a solvent for the dye layer of Hurditch because Cunningham teaches that solvents such as 2,2,3,3-tetrafluoro-propanol is selected for its minimal effect on the substrate.

Response to Arguments

7. Applicant's arguments of rejection under 35USC 102(e) have been fully considered but are unpersuasive. Applicant states, "there is no indication in the reference that the reflective layer is applied to a dye layer whereby no drying step has occurred on the dye layer. That is Hurditch et al. '073 does not disclose, teach or suggest the absence of a drying step." Examiner respectfully disagrees. Applicant is reading into what the reference is implying. The reference specifically teaches "the dye layer may be optionally dried" meaning that the layer does not have to be dried. Applicant further argues that "Hurditch et al. '073 fails to disclose, teach or suggest a content of the organic solvent in the organic dye layer." Examiner disagrees, Hurditch et al. '073 discloses the recording layer is formed by dissolving the dye mixture in a coating solvent and teaches organic solvents for use with the dye mixtures (column 10, lines 26-45) which teaches a content of the organic solvent in the organic dye layer. Regarding the case law, the examiner does not find the case relevant (Verdegall Bros. V. Union Oil Co. of Calif.). Every feature is shown by Hurditch.

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Applicant's arguments of rejection under 35USC 103(a) have been fully considered but are unpersuasive. Applicant fails to disclose reasons why Hurditch in view of Cunningham et al. therefore the rejection is upheld.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.

Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

